

REMARKS

Claims 15-34 were pending in the application. Claims 19, 20, 26, and 29 have been amended. Upon entry of these amendments, Claims 15-34 will be pending and under active consideration. Claims 15 and 27 are independent.

The claims have been amended to more particularly point out and distinctly claim that which Applicants regard as their invention, as well as to correct certain inadvertent typographical errors. In particular, claim 20 has been amended to replace the word "and" with the intended word "or." Claim 29 has been amended to remove the inadvertent double recitation of the term "microparticles." Claims 19 and 26 have been amended to add a space where deemed appropriate.

Applicants submit respectfully that the amendments presented herein are supported fully by the claims and/or specification as originally filed and, thus, do not represent new subject matter.

Applicants respectfully request entry of the amendments and remarks made herein into the file history of the present invention. Reconsideration and withdrawal of the rejections set forth in the above-identified Office Action are respectfully requested.

I. The Double Patenting Rejection Should Be Withdrawn

The Office Action, at paragraph 16, rejects Claims 15-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-18 of U.S. Patent No. 6,548,075 to Benges *et al.* (hereinafter, "Benges"). The Office Action alleges that Applicant's claims are directed toward a sun protection product with microparticles on the basis of water-insoluble linear polyglucans. The Office Action alleges further that although the

allegedly conflicting claims are not identical, they are not patentably distinct from each other because the instant application is claiming a sun protection product which comprises the same topical preparation as the Bengs patent. The Office Action alleges further that the Bengs patent broadly states that the preparation is for topical use as a cosmetic. The Office Action finally suggests that Applicants may overcome the reference either by a showing under 37 CFR § 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another", or by antedating the reference under 37 CFR § 1.131. Applicants traverse respectfully.

At the outset, Applicants respectfully submit, and confirm for the record, that the above-identified application and U.S. Patent No. 6,548,075 issued to Bengs are subject to an obligation of assignment to the same entity, Celanese Ventures GMBH. This is evidenced by the face page of U.S. Patent No. 6,548,075, and by the Notice of Recordation and Assignment dated May 14, 2002, which indicates that the above-identified application has been assigned to Celanese Ventures GMBH, as evidenced by the recordation of the assignment at Reel/Frame 012897/0332 (Exhibit A).

Applicants respectfully submit, however, that contrary to the assertion in the Office Action, Claims 15-34 are not properly subject to rejection under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over Claims 1-18 of U.S. Patent No. 6,548,075 to Bengs.

The Examiner is respectfully reminded that in order to establish double patenting between a patent and an application, the claims of the second application must be compared against those of the issued patent. Subject matter *disclosed* but not claimed in the patent is not used in determining double patenting. *See, e.g., In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986);

Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082 (Fed. Cir. 1985) *remanded*, 475 U.S. 809 (1986), *on remand*, 810 F.2d 1561 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (double patenting involves a comparison of the claims of the multiple patents; a prior patent is not "prior art" as to a later patent by the same inventor). However, the first patent's disclosure may be used to interpret its claims. *In re Avery*, 518 F.2d 1228 (CCPA 1975).

In this case, while the Office Action correctly asserts that Bengs discloses a topical formulation for use as a cosmetic or medicinal preparation to provide an increase in the feel of softness on the skin, Applicants respectfully submit that both the specification and claims of Bengs are completely silent as to the composition being a sun protectant and its use in a method of sun protection as is claimed by Applicants in the above-identified application. Indeed, Applicants' careful study of the entire disclosure of the Bengs reference does not reveal any such teaching or suggestion.

In particular, Applicants submit respectfully that Bengs at most teaches that the cosmetic compositions may also be described as bodycare compositions and decorative compositions (Column 1, lines 64-67). For example, Bengs provides examples of the decorative cosmetics being creams, powders, or foundations for make-up, e.g. rouge, eye shadow, lipsticks (Column 2, lines 8-10). Bengs further states that microparticles of the composition are particularly suitable as fillers if a particularly soft smooth powdery effect is to be achieved, in addition to imparting to the skin a soft matt appearance similar to the soft focus effect in photography (Column 9, lines 58-65). Bengs also indicates that on account of the absorbant effect of the microparticles, they are particularly highly suitable as an additive in deodorants, body powders such as body talc, for the absorption of excess skin fat, e.g. in anti-oil or antiacne products (Column 10, lines 8-12). Finally, Bengs indicates that the microparticles are able to reduce skin roughness, by and large

have a soothing effect on the skin, and exert an emollient and moisturizing action. Nowhere in the specification of Bengis is there any mention whatsoever of use of the present composition as a sun protectant. Applicants submit respectfully that all of the pending claims, as amended are quite explicit in requiring that the composition be a sun protectant and that it be used in a method for sun protection.

Thus, Applicants submit respectfully that, contrary to the Office Action's allegation, Bengis does not teach or suggest in any way a sun protection product comprising microparticles on the basis of water-insoluble linear polyglucans.

Accordingly, in light of the foregoing, Applicants submit respectfully that the rejection of Claims 15-34 under the judicially created doctrine of obviousness-type double patenting has been overcome. Reconsideration and withdrawal of the rejection of Claims 15-34 under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

CONCLUSION

Applicants submit respectfully that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

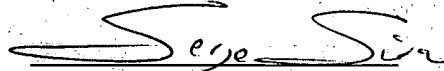
Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3500. All correspondence should be directed to our address given below.

AUTHORIZATION

Applicants believe there is no fee due in connection with this filing. However, to the

extent required, the Commissioner is hereby authorized to charge any fees due in connection with this filing to Deposit Account 50-1710 or credit any overpayment to same.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Gilberto M. Villacorta", written over a horizontal line.

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